

### **REMARKS/ARGUMENTS**

Claims 8-13 and 15-20 are pending in the present application, of which claims 8, 15 and 20 are independent claims. Claims 1-7, 14 and 21-30 have been canceled without prejudice or disclaimer. Claims 8-13, 15-18 and 20 have been amended by this Amendment.

### **Claim Rejections under 35 USC § 103**

Claims 8-13 and 20-26 stand rejected under 35 USC § 103(a) as unpatentable over Shieh et al. (U.S. Pat. No. 6,591,098, hereinafter "Shieh") in view of MCI Communications Corporation (WO 97/01253, hereinafter "MCI"). Claim 15 stands rejected under 35 USC § 103(a) as unpatentable over Shieh in view of Shannon et al. (U.S. Pat. No. 6,285,869, hereinafter "Shannon"). Claims 16-18 stand rejected under 35 USC § 103(a) as unpatentable over Shieh and Shannon in view of MCI. Claim 19 stands rejected under 35 USC § 103(a) as unpatentable over Shieh in view of Shannon and Borngraber (U.S. Pub. No. 2004/0120552, hereinafter "Borngraber"). Claims 28-30 stand rejected under 35 USC § 103(a) as unpatentable over Shieh in view of MCI and Borngraber.

### **Summary of subject matter disclosed in the specification**

The following descriptive details are based on the specification. They are provided only for the convenience of the Examiner as part of the discussion presented herein, and are not intended to argue limitations, which are unclaimed.

Applicants' disclosed embodiments are directed to a remote SIM card activation process when, for example, an old SIM card is being replaced by a new SIM card that can handle different and/or additional services for a particular subscriber. The old account is to be deactivated in favor of the new account being activated.

The old SIM card contains account information for the old account, such as the account identifier, which is prestored in a remote system. The new SIM card contains account information for the new account, such as a one-time account identifier, designed for a one-time logon to the network, and a new permanent account identifier intended to replace the old account identifier. The one-time and permanent account identifier for the new SIM card are prestored in a remote system.

The existing account information is copied from the old SIM card to the new SIM card by a suitable copying device. The new SIM Card authenticates itself with the network using the one-time account identifier. Upon successful logon to the network using the one-time account identifier, an Auto-Activation application in the new SIM card sends out an Activation Request to the network. The application sends information that includes, for example: the old account identifier copied from the old SIM card and the new permanent account identifier that is to be enabled.

Upon successful sending of the Activation Request, the following operation occurs within the new SIM card. The Auto-Activation application exchanges the one-time account identifier with the permanent account identifier. Accordingly, the new SIM card automatically activates itself and exchanges the permanent parameter in place of the one-time parameter upon successful logon to the network. This is accomplished without receiving the permanent account identifier or other any instruction from the network. Moreover, it is done by storing the new account information on the network “just-in-time”, and not earlier, to thereby make efficient use of network resources only when they are actually needed, i.e. only upon the new account being activated for the new SIM card.

Accordingly, Applicants' disclosed embodiments are not required to provision all the account information into various network systems before activation. The activation will instead be done in a "just-in-time" fashion which greatly saves space on the network, and the use of the one-time account identifier thus eases the number of activated subscriptions required to be stored by the network. Moreover, Applicants' disclosed embodiments use the same one-time account identifier for every account. That is, for a plurality of different new SIM cards intended for use on the network, each of the new SIM cards uses the same one-time account identifier. Furthermore, a user can keep the same data and settings from a previous SIM card when the user changes to a new SIM card.

#### Arguments

The art cited by the Examiner fails to disclose, teach or suggest "said one-time and permanent account identifier are prestored in said at least one remote system" and "deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module and activating the permanent account identifier attached to the first subscriber identifying module", as expressly recited by Applicants' independent claim 8.

Shieh discloses a system and a method for activating a subscriber identification module (SIM) based mobile device in a PCS/ANSI type wireless network. The method of Shieh includes preprogramming the SIM card of the mobile device with temporary activation identifiers, such as an international mobile station identity (IMSI) and/or a mobile identification number (MIN), and a temporary electronic serial number (ESN). The temporary ESN, rather than the mobile device actual ESN, is used to identify the mobile device during registration and activation. The network identifies the temporary ESN associated with the SIM vendor and invokes an over-the-air

activation procedure especially for the SIM card mobile devices. A SIM-over-the-air-activation processor is notified to perform the activation for that mobile device on the PCS wireless network. Authentication of the mobile device may be bypassed and the mobile device is instructed to transmit its actual electronic serial number for future registrations (See Abstract of Shieh). More specifically, Shieh explains at col. 7, lines 3-6 that “After activation, the network instructs (214) the mobile device to transmit the actual electronic serial number (ESN) for future registrations. This is accomplished by setting the usage indicator [in the SIM] to send the actual ESN in the future.” Shieh then further teaches in the following step 216 that the method finally comprises overwriting the temporary network activation identifiers so that the actual electronic serial number of the mobile device is not reported to the network until the over-the-air activation is completed.

Shieh fails to disclose, teach or suggest that the actual electronic serial number is prestored in any system remote from the mobile device/SIM card. The Examiner cites col. 3, lines 11-20 and col. 5, lines 36-49 of Shieh as teaching that the one-time account identifier is prestored in the at least one remote system. Applicants respectfully disagree. According to Shieh, the network identifies the SIM electronic serial number as a temporary ESN associated with the mobile device and a removable card vendor. This identification is preferably accomplished using the home location register (HLR), but may also occur at a Message Center (MC). The HLR or MC will identify the mobile device as a SIM device via the S-ESN and notify the correct vendor SIM. In other words, Shieh only teaches that the HLR or the MC will identify the SIM via the S-ESN. Nothing in the cited passages of Shieh teach or suggest that the S-ESN is prestored at the HLR or the MC, as recited in Applicants’ claim 8. Shieh thus fails to disclose, teach or suggest “said one-time and permanent account identifier are prestored in said

at least one remote system”, as expressly recited by Applicants’ independent claim 8.

Furthermore, Shieh fails to disclose, teach or suggest that a remote system, e.g., the HLR, stores a parameter identifying a current active account that is attached to a second subscriber identifying module. In particular, Applicants’ independent claim 8 recites “deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module”. The remote system therefore cannot be the second subscriber identifying module in Applicants’ claimed invention. The Examiner already acknowledges (at page 5) of the Office Action that Shieh fails to disclose “deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module”. The Examiner instead relies on MCI as disclosing these features. In particular, the Examiner states that MCI teaches “The replacement (new) card is fully activated, while the old (second) SIM card is disabled”. MCI thus teaches only deactivating an old SIM card.

MCI therefore fails to cure the deficiencies of Shieh, and the Examiner’s proffered combination of Shieh and MCI fails to disclose, teach or suggest “deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module”, as expressly recited by Applicants’ claim 1 because, as previously noted, the remote system is not a second subscriber identifying module in Applicants’ claimed invention.

Independent claim 8 is accordingly deemed to be patentable over the cited art. Independent claims 15 and 20 recite features similar to claim 8 and are therefore patentable over the applied prior art for reasons discussed above with respect to claim 8, as well as on their own merits. Claims 9-13 and 16-20, which each depend from one of independent claims 8 and 15, distinguish the invention over the applied prior art for reasons discussed above in regard to claims 8 and 15, as well as on their own merits.

Withdrawal of these rejections is therefore requested.

**CONCLUSION**

This application is now believed to be in condition for allowance, and early notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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